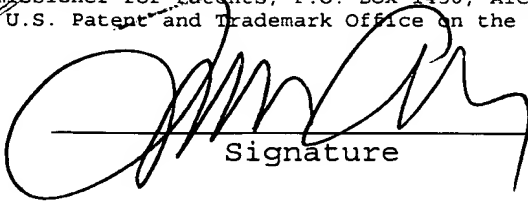


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Signature

December 5, 2005

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No. : 09/538,792 Confirmation No. 7892
Applicant : Vincenzo Scotto Di Carlo, et al.
Filed : March 30, 2000
Title : Method for Giving Notification of a Message
to a Subscriber
Group Art Unit : 2645.0
Examiner : Joseph T. Phan

Docket No. : GR 97 P 2659 P
Customer No. : 24131

REPLY BRIEF

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S i r :

This is a *Reply Brief* responding to the *Examiner's Answer*
mailed October 5, 2005.

Arguments:

Appellant comments as follows with respect to the Examiner's Answer dated October 5, 2005 ("Examiner's Answer").

Grounds of Rejection:

I. Claim 1 is not indefinite under 35 U.S.C. § 112, second paragraph.

As stated in the Appeal Brief, any reasonable reading of claim 1 leads the reader to the conclusion that "the message" in the "in contrast" can only refer to the previously recited "new message". Even if the amendments to claim 1 made in the last response, are never entered, Appellants maintain that the claim would not be indefinite. As set forth above, it is clear that claim 1 recites, in contrast to sending the message, transmitting an indication of the receipt of the previously recited new message.

II. Claims 1 - 12 are believed to be allowable over U. S. Patent No. 6,333,973 to Smith, et al ("SMITH"), as SMITH is believed to be uncitable against the present claims.

Appellants reallege and incorporate herein the arguments made in their Appeal Brief.

Further, page 4, paragraph 1 of the Examiner's Answer states:

Appellant argues that the Smith patent, #6,333,973, filed 04/23/1997 cited above is not available as prior art against the present claims because of submittal of a 37 C.F.R. § 1.131 declaration dated 4/24/1997 [sic]. Examiner respectfully disagrees as the declaration has been considered but is ineffective to overcome the Smith patent. [emphasis added by Appellants]

Appellants respectfully disagree that the declaration was considered, but found to be ineffective to overcome the SMITH patent. Appellants have twice filed 37 C.F.R. § 1.131 declarations in the above named case: on December 6, 2002, and on December 23, 2004. Copies of both declarations were appended to the Supplemental Appeal Brief in the Evidence Appendix, as required by 37 C.F.R. § 41.37. The facts appear to support that Appellants' 37 C.F.R. § 1.131 declaration of December 6, 2002, was considered and found to be effective to overcome the SMITH patent, which was withdrawn as a reference in the Office Action of February 27, 2003, subsequent to the first filing of Appellants' 37 C.F.R. § 1.131 declaration addressed to SMITH.

The sequence of relevant events surrounding the filing of the two 37 C.F.R. § 1.131 declarations is as follows:

On April 23, 1997, the application that resulted in U. S. Patent No. 6,333,973 to Smith ("SMITH") was filed in the United States Patent and Trademark Office.

On September 30, 1997, the application from which the present application claims priority was filed in Germany.

On **September 7, 1998**, a PCT application, PCT/DE98/02629, was filed claiming priority from the above German Application

On **March 30, 2000**, the present application was filed as a continuation of PCT/DE98/02629.

On **May 23, 2002**, a first Office Action issued in the present case, in which originally filed claims 1 - 12 were rejected as allegedly being anticipated by the **SMITH** patent.

On **October 23, 2002**, Applicants filed a response to the first Office Action, amending claims 1 and 4 - 7 and arguing the patentability of the claims, over the **SMITH** reference.

On **December 6, 2002**, prior to the mailing of a final Office Action, Appellants filed a Supplemental Response, including a 1.131 Declaration swearing back of the **SMITH** reference cited in the first Office Action. The 1.131 Declaration filed at that time stated that the invention was reduced to practice before April 23, 1997. The Declaration included as corroborating evidence, an invention disclosure signed and dated by the inventors on **April 24, 1997**.

On **February 27, 2003**, a second Office Action, which was made final, was mailed. The Final Office Action was noted as being responsive to the communication filed on "11 December 2002", and thus was responsive to Applicants' Supplemental Response. In the Office Action, claims 1 - 12 were now being rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U. S. Patent No. 6,233,318 to Picard et al., ("**PICARD**"), which was filed in the United States Patent and Trademark Office on November 5, 1996. The **SMITH** reference was not mentioned in the Final Office Action, nor was it alleged that Applicants' 1.131 Declaration or the proof offered was insufficient in any way. Rather, in the section of the Office Action entitled "Response to Arguments", the Examiner merely stated:

"3. Applicant's arguments with respect to claims 1 - 12 have been considered but are moot in view of the new ground(s) of rejection."

On **May 23, 2003**, in response to the Final Office Action, Applicants' filed an Amendment under 37 C.F.R. § 1.116, in which the patentability of the claims were argued over the **PICARD** reference.

On **June 27, 2003**, Applicants filed a request for continued examination (RCE) in the present case to further argue the patentability of the claims over the **PICARD** reference.

On **November 21, 2003**, a third Office Action was mailed in the present case. In the third Office Action, all claims again stood rejected based on **PICARD**. The third Office Action did not mention the **SMITH** reference, nor did it discuss any alleged insufficiency in Applicants' previously filed § 1.131 Declaration or the proofs offered therein.

On **April 21, 2004**, in response to the third Office Action, Applicants amended claim 1 and further argued of the claims, now claims 1 - 14, over the **PICARD** reference.

On **July 23, 2004**, in a fourth Office Action, which was made final, Applicants' claims (only claims 1 - 12 were listed) were now rejected, again, over the **SMITH** patent, which Applicant had previously sworn behind in **response to the first Office Action**.

On **December 23, 2004**, in a response to the fourth Office Action, Applicants' referenced the 37 C.F.R. § 1.131 Declaration, previously filed by Applicants' on December 6, 2002. Applicants' additionally filed a further 37 C.F.R. § 1.131 Declaration, signed by inventor Vincenzo Scotto Di Carlo.

On **January 31, 2005**, in the Advisory Action following Applicants' response to the fourth Office Action, the Examiner stated:

"The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicant did not provide sufficient reduction to practice evidence to overcome the prior art of record, Smith et al., Patent #6,333,973 filed April 23, 1997. The submitted Declaration 131 filed December 6, 2002 includes a proposed disclosure of the invention which merely shows that it was Conceived Proposal, Not Reduction to Practice as needed (i.e. test results, operational evidence, etc.). Not only does the submitted evidence shows [sic] only Conception, it is dated April 24, 1997, which is after the filing date of the Smith Patent. It is also noted that applicant's pending patent application was filed March 30, 2000."

In view of the foregoing sequence of events, it would appear from the file history of the present patent application that the first 37 C.F.R. § 1.131 affidavit appears to have been entered (i.e., removing the Smith reference from use in rejecting the claims and "mooting" that grounds for rejection) by the Examiner in the Office Action of February 27, 2003.

Further still, page 4 of the **Examiner's Answer**, second paragraph, states, in part:

Appellant has failed to prove conception or reduction to practice of the invention Prior to the effective date of the Smith reference. **The evidence submitted by appellant which is written as a 'patent proposal' is dated 04/24/1997, a day After the effective date of the Smith reference.** Furthermore, merely alleging that conception and reduction to practice occurred before the Smith reference is not sufficient. At a minimum, MPEP § requires there must be evidence that proves at least conception of the claimed invention Prior to the Smith patent coupled with due diligence from prior to the reference date.

Appellants disagree that they have not proven conception and reduction to practice prior to the effective date of **SMITH**.

First, in Appellants' 37 C.F.R. § 1.131 declaration filed with the Supplemental Response of December 6, 2002, both inventors named in the present case have declared that "[t]he invention of the above-identified application was 'reduced to practice' before April 23 1997". As such, you have the declaration of

the inventors that the invention was reduced to practice prior to the effective date of the **SMITH** reference.

Second, the inventors attached to the declaration filed with the Supplemental Response of December 6, 2002, a thoroughly **detailed and illustrated** Invention Disclosure (Erfindungsmeldung), labeled on each page as the MWI server patent proposal and having a date on each page of April 24, 1997. Further, both inventors signed the Invention Disclosure including the "MWI server patent proposal" on April 24, 1997. As such, although the Invention Disclosure was signed and dated as of April 24, 1997, *one day after the effective date of SMITH*, the very appearance of the Invention Disclosure (i.e., the detail, the computer-generated illustrations, etc.), **is**, in fact, **the very evidence** that the invention was conceived of at least as early as the previous day (i.e., the effective date of **SMITH**).

In Greek Mythology, the goddess Athena emerged, fully mature, from the head of her father Zeus, wearing full armor and uttering a war cry. Contrary to mythology, neither children, nor inventions, emerge from the heads of their inventors fully mature, especially those documented on paper and fully supported by elaborate illustrations and flow charts. The volume of detail regarding the invention, contained in Appellants' Invention Disclosure, including detailed

explanations and detailed illustrations, is, itself, the conclusive proof required by the MPEP, that the inventors were in possession of the full invention at least as early as the day before the date on each page of the patent proposal of April 24, 1997. Such an effort, as documented by Appellants' invention disclosure, could not have both "emerged fully mature" from the inventors' heads and been documented in the elaborate MWI server patent proposal, all on the same day. Appellants' maintain that the volume and quality of the Invention Disclosure, itself, is proof of at least conception, prior to the date of April 24, 1997, dated on each page of the Invention Disclosure. Coupled with Appellants' declaration that the invention was reduced to practice prior to April 23, 1997, the Invention Disclosure is believed to be the supporting proof necessary to remove the SMITH reference from being cited in the present case.

As such, Appellants' believe that the conception and reduction to practice of the presently claimed invention, prior to the effective date of SMITH, is fully documented by the evidence presented in the case, and that the SMITH patent should be removed as a reference against Appellants' claimed invention.

Page 6 of the Examiner's Answer states, in part:

It is also noted that appellant contradicts his statements on page 20 - 21 of the brief. Stating on

one hand, that both inventors have sworn in the declaration of November 2002, that "the present invention was reduced to practice prior to April 23, 1997", the filing date of the Smith patent on the other, appellant states at the top of page 21, that "diligence is shown by filing of a patent application (German) on the disclosed invention only about five months after the Invention Disclosure was signed..." Here Appellant admits diligence is shown After the proposed invention disclosure, dated April 24, 1997, which allegedly was already reduced to practice by the inventors. Therefore one would assume the invention disclosure, if already reduced to practice, would incorporate language or evidence of a system that was operational and running, rather the invention disclosure incorporates a proposal of how the system should and may operate (see the term "may" used throughout the proposal pages 3-4). [emphasis in original]

Appellants disagree that a declaration of reduction to practice prior to April 23, 1997, "contradicts" a statement of diligence towards the filing of the German patent application, from which the present application claims priority. More particularly, Appellants have **declared** that the invention was reduced to practice prior to April 23, 1997. Any further showing of diligence until the filing of a patent application may be unnecessary, if the declaration is taken on its face as true, but does not constitute a contradiction. However, as in the present case, where the Examiner is alleging that merely declaring reduction to practice prior to the effective date is not "evidence", and is thus disputing Appellants reduction to practice, a showing of diligence up to the filing of the German application, coupled with earlier conception (i.e., as evidenced by the detailed, illustrated Invention Disclosure,

discussed above), is further proof of Appellants' prior invention (i.e., prior conception and diligence to filing date of the application). As such, in the alternative, Appellants are showing under two different rules, a showing under only one of which is necessary, that Appellants meet their burden required to remove the **SMITH** reference as prior art to Appellants' claimed invention: 1) Appellants' prior reduction to practice prior to April 23, 1997, as evidenced in the Declaration filed December 6, 2002; and 2) In the alternative, Appellants' prior conception (evidenced by documentation set forth in the Invention Disclosure) and due diligence until filing the German application. Although only one of the above showings is necessary to remove **SMITH**, Appellants have made both showings in the event that, as alleged in the **Examiner's Answer**, the declaration of the Inventor's stating prior reduction to practice, is not enough to persuade the Board of that fact. As such, Appellants have offered more proof than necessary, that the **SMITH** reference is not citable against the claimed invention, but Appellants do not agree that making the extra proof is a contradiction, as alleged in the **Examiner's Answer**.

Appellants note that, in the very first Office Action in the above case, acknowledgement was made of Appellants' claim for priority from an international application, although the Examiner noted that the priority was not yet granted because

Applicants had not yet complied with the requirements of 35 U.S.C. § 371. Appellants stated in the next response, and still maintain, that the appropriate documents will be submitted at a later stage in the proceedings.

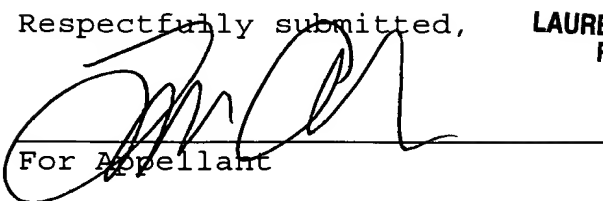
In view of the foregoing, Appellants believe that they have provided ample proof of conception and reduction to practice prior to the effective date of **SMITH** and/or conception at least as early as the effective date of **SMITH** and due diligence from the effective date of **SMITH** to the filing date of a patent application on the presently claimed invention. As such, Appellants respectfully request the Board to reverse the Examiner's holding of the use of the **SMITH** reference against the Appellants' claimed invention.

III. Conclusion.

Based on the above given arguments the honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

Respectfully submitted,

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For Appellant

December 5, 2005

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